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EXAMINER

HARRELL, ROBERT B

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2142

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/877,522
Filing Date: June 08, 2001
Appellant(s)

David R. Risley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 October 2005 appealing from the Office action mailed 09 May 2005.

I. Real Party in Interest

A statement identifying the real party in interest is contained in the brief and is acknowledged.

II. Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief and is acknowledged.

III. Status of Claims

This is an Answer to an appeal from the final rejection of claims 1-20, which are all the claims in the case. Examiner agrees with the statement of the status of the claims contained in the appellant's brief.

IV. Status of Amendments

Examiner agrees with the statement of the status of amendments contained in the appellant's brief.

V. Summary of claimed subject matter

Examiner agrees with the summary of the invention contained in the appellant's brief.

VI. Grounds of rejection to be reviewed on appeal

Examiner agrees with the issues presented for review as contained in the appellant's brief.

VII. Argument

Examiner acknowledges the presence of arguments within the brief.

VIII. Claims appendix

Examiner agrees that the copy of the claims on appeal is correct.

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IX. References of Record

The following is a listing of the references of record relied upon for establishing each of the two rejections under 35 U.S.C. 102(e):

U.S. Patent	6,680,749 B1	Anderson et al.	filed	November 06, 1997;
U.S. Patent	6,222,538 B1	Anderson	filed	February 27, 1998.

The following is a listing of the references of record relied upon for establishing each of the four rejections under 35 U.S.C. 103(a):

U.S. Patent	6,680,749 B1	Anderson et al.	filed	November 06, 1997;
U.S. Patent	6,636,259 B1	Anderson et al.	filed	July 26, 2000;
U.S. Patent	6,567,122 B1	Anderson et al.	filed	March 18, 1998;
U.S. Patent	6,222,538 B1	Anderson	filed	February 27, 1998.

X. Grounds of Rejections**X-I Ground of Rejections under 102(e)**

1. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Examiner's Answer will usually refer attention to relevant and helpful elements, figures, and/or text upon which the Examiner's Answer relies to support the position(s) taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference(s) is(are) cited* and relied upon in this Examiner's Answer as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

2. **Claims 1-20 are rejected under 35 U.S.C. 102 (e)** as being anticipated by

Anderson et al (US 6,680,749 B1);

OR, in the alternative, as being anticipated by

Anderson (US 6,222,538 B1).

These are two specific rejections under 35 U.S.C. 102(e).

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3. Per claim 1, Anderson (US 6,680,749 B1) taught an image capture appliance (e.g., see figure 1 (110) and col. 5 (lines 1-17)) configured for connection to a network (e.g., see col. 12 (lines 14-19)) and communication with a device connected to the network (e.g., see col. 12 (lines 14-19)) (i.e., to the device to which a digital image is sent), the appliance comprising:

a) a processing device (e.g., see figure 3 (344)) configured to control operation of the image capture appliance (e.g., see col. 5 (line 36) to col. 6 (line 33));

b) memory (e.g., see figure 3 (346 and/or 350 and/or 354)) including logic configured to receive software (e.g., see figure 12 (760)) via the network that facilitates communication between the image capture appliance and the device from a software source (e.g., see col. 12 (lines 14-19)); and,

a) a network interface device was anticipated such that the image capture appliance could communicate with the software source (e.g., see col. 12 (lines 14-19)) to obtain the software 760 when it became available.

4. Per claims 2 and 3, accepting application program 760 was an indication of approval for the application program by the user authorizing the updated application program 760.

5. Per claims 4,5,6,7, and 8 in order to obtain software 760 in figure 12, it was anticipated that the digital camera actively looked for and retrieved software from the software source (i.e., that which provided application program 760 via the network to the camera) from time to time as application programs were known to become obsolete in favor of more updated driver versions. Clearly, the download could not come to pass if the application program was not available.

6. Per claims 9,10,11,12,13,14,15,16,17,18,19, and 20 these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above.

7. **Claims 1-20 are rejected under 35 U.S.C. 102 (e)** in the alternative; like Anderson (US 6,680,749 B1), Anderson (US 6,222,538) taught the same overall structure of the network programmable digital camera as the same per figures 1-5, of Anderson (US 6,222,538) with figures 1-5 Anderson (US 6,680,749 B1), and including programming the digital camera from a remote location over a network as covered in col. 10 (lines 40-49) in conjunction with figure 10 of (6,222,538 B1). Thus the grounds cited above also applies to Anderson (6,222,538 B1). Also, Anderson (US 6,222,538 B1) taught in figure 11, searching for system application program files and installing selected application programs for running on the digital camera. Since the user selected the application program, such a selection was an authorization to install and run the program.

8. In summary, each of the above cited Anderson reference, alone, taught of programming a digital camera which could be directly connected to a network (i.e., not via a Personal Computer and then to a network through a USB connection of the Personal Computer); in other words, a programmable network digital camera with direct connection to a network to load communications software from a software source via the network.

X-II Ground of Rejections under 103(a)

9. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Anderson et al (US 6,680,749 B1) in view of *Anderson et al. (US 6,567,122 B1)*; OR,

Anderson et al (US 6,680,749 B1) in view of *Anderson et al. (US 6,636,259 B1)*. OR,

Anderson (US 6,222,538 B1) in view of *Anderson et al. (US 6,567,122 B1)*; OR,

Anderson (US 6,222,538 B1) in view of *Anderson et al. (US 6,636,259 B1)*.

These are four specific rejections under 35 U.S.C. 103(a).

10. Per claims 1-20, that which was anticipated was obvious and thus the reasoning cited above continues herein and below as standing obvious.

11. Per claim 9, and those like with respect to direct connection to a network, while Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) did not specifically put pen to paper reciting specific wordage that his network programmable digital camera image capture device was "configured for direct connection to a network", as indicated above, it was anticipated from col. 12 (lines 14-19) in Anderson (US 6,680,749 B1) and Anderson (US 6,222,538 B1) col. 10 (lines 40-49) that the camera was directly connected to the network since each reference also provided a direct connection to a host computer (i.e., Personal Computer via USB) as an alternative which logically implies an alternative direct connection to a network not through the host computer but rather the camera was directly connected to a network via a network interface; and, thus with connection to a host computer as one of two options, receiving the application program directly from the network was obvious since a direct connection to a network was one of the two options which included direct connection to the host computer (Personal Computer via USB). In other words, since one option was to obtain the application program from the host computer and the other from the network, the one from the network must not include the one from the host computer else it too would be from the host computer and thus no second option. Thus connecting the network programmable digital camera image capture device directly to the network via a network interface was obvious to those skilled in the art. Nonetheless, the same type camera covered by Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) was also covered by Anderson (US 6,567,122 B1) as shown in figures 1-5B as identical to those of figures 1-5B of Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) figures 1-5 and described in Anderson (US 6,636,259 B1). That is, Anderson (US 6,567,122 B1) or Anderson (US 6,636,259 B1) modified the network programmable digital camera as covered in Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) for direct connection to a network. Since the inventor himself made the modification, such a modification would have been obvious to those skilled in the art such as Anderson himself.

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12. It would have been obvious to one skilled in the network programmable digital camera data processing art to have combined the teachings of these references, as indicated above, because they each were directed toward the problem of directly connecting a network programmable digital camera to a network. Also, since Anderson (US 6,567,122 B1) or Anderson (US 6,636,259) post dated Anderson (US 6,680,749 B1), it would have been obvious to those skilled in the art to implement the Web Server application program in Anderson (US 6,567,122 B1) or Anderson (US 6,636,259 B1) as the application program 760 in Anderson (US 6,680,749 B1). Furthermore, each of the reference had the same inventor. The same logic holds for Anderson (US 6,222,538 B1) in view of either Anderson (US 6,567,122 B1) or Anderson (US 6,636,259 B1). That is, loading, from the network, the Web Server application program of either Anderson (US 6,567,122 B1) or Anderson (US 6,636,259 B1) as the alternative application program in either Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) would have included the required communication software to allow the digital camera to communicate with another device on the network using HTML and TCP/IP.

13. Anderson et al. (US 6,567,122 B1) or Anderson (US 6,636,259 B1) taught a programmable digital camera, of the exact same type as covered in Anderson et al (US 6,680,749 B1) or Anderson (US 6,222,538 B1), directly connected to a network not via a Personal Computer (i.e., digital camera connected via USB to a Personal Computer which Personal Computer was then connected to a network). Thus communication application software could obviously be obtained via a direct network connection to the digital camera with no Personal Computer in-between for this type of digital camera in Anderson et al (US 6,680,749 B1) or Anderson (US 6,222,538 B1). Also, since Anderson (US 6,680,749 B1) or Anderson (US 6,222,538 B1) did not recite a communication Web Sever application program as in either Anderson (US 6,567,122 B1) or Anderson et al. (US 6,636,259 B1), it was obvious to those skilled in the art to view such Web Server application programs as the downloaded application program 760 of Anderson (US 6,680,749 B1) or downloaded program script of Anderson (US 6,222,538 B1).

XI. Response to Argument

1. Per the appellant's arguments, beginning on page 6, the appellant argued the rejection under 102(e) as anticipated by Anderson U.S. Patent 6,680,749 B1 by stating in substance that:

a) Anderson does not appear to say anything else about receiving software with a digital camera from a network. For example, Anderson does not teach providing software to a digital camera, or any other appliance for that matter, wherein the software facilitates communications between the appliance and another device. **However**, Anderson taught a memory (e.g., see figure 3 (346 and/or 350 and/or 354)) including logic configured to receive software/program (e.g., see figure 12 (760)) via the network that facilitates communication between the image capture appliance and the device from a software source (e.g., see col. 12 (lines 14-19)). Figure 12 clearly taught loading/plugging-in software/program 760 into 350 while col. 12 (lines 14-15) taught such software/program was downloading from a network, then clearly from the whole of Anderson, software/program application 760 was downloaded from a network along with the software/program also downloaded either from a removable memory, from the host computer, or

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from, again, the network. As for the argued example of the software facilitating communication between the appliance and another device, software by its nature communicates outside of itself (i.e., data in data out); to not do so would result in a black box with no utility. The software/program 760 receives data, processes that data, and returns a result that is then anticipated to be utilized by the digital camera thus effecting the functions of the digital camera thus effecting any data exchange between the camera and another device and thus the software facilitates communication between the digital camera and another device. As stated from lines 5-42) control is passed from the main control program 750 (line 5) to the application 760. If 760 does not include communication controls, the digital camera loses its ability to communicate with the outside world. Per col. 12 (lines 5-13) the control program 750 uses drivers 754 that are used for external communications, when control is passed from control program 750 to application 760, so to does usage of drivers 754 pass to the application 760 that uses those drivers for external communications and thus application 760 facilitates communications between the appliance (digital camera) and to another device. It should be noted that application 760 clearly uses the devices internal to the appliance and thus too facilitates communication between the appliance and display, memory, button, and the like. However, the main thrust is that control 750 uses drivers 754, when control is passed to application 760 so are control over drivers 754. If control is passed from 750 to 760 (col. 12 (lines 35-36), and 760 cannot facilitate communications between the digital camera and another device (i.e., via drivers 754), the camera is useless;

b). regarding claim 1, the appellant notes that Anderson does not teach an image capture appliance that includes logic configured to receive software . . . that facilitates communication between the image capture appliance and another device. **However**, as indicated above, such logic was the network connection and since application 760 gain control of the camera the camera, to be useful, had to continue to communicate. One form of communication would be application 760 displaying a photo on screen figure 5A (402) or usage of drivers 754 for "external communication" (col. 12 (lines 9-13)). Application 760 must be able to communicate with the outside world else the camera would be useless;

c) nothing in the Anderson disclosure states that Anderson's digital camera comprises communication software before the new user interface is downloaded to the camera. **However**, as indicated during prosecution, col. 12 (lines 9-13) taught communications to which control application 750 has access and to which application 760 has access when control was passed from control application 750 to newly downloaded from the network application 760;

d) assuming that Anderson's digital camera originally comprised such software, nothing in Anderson's disclosure states that the user interface software that is downloaded to the digital camera would replace any such communication software. In fact, the user interface software presumably would not replace any communication software because the user interface software pertains to the user interface, i.e., what the user interacts with, not what another device would interact with. **However**, as indicated, driver 754 provided for "external communication" which was implemented by control application 750 that was then inherited by application 760 when control was passed from control application 750 to application 760. Codes within application 760 that implemented 754 was communication software within application 760, to state that there was no code (software) means application 760 communicated with nothing external and to the user, the camera would appear dead. Application 760 was anticipated to talk to the world;

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e) Anderson does not teach periodically searching for software for the appliance. **However**, it was anticipated that the digital camera actively looked for and retrieved software from the software source (i.e., that which provided application program 760 via the network to the camera) from time to time as application programs were known to become obsolete in favor of more updated driver versions. Clearly, the download could not come to pass if the application program was not available. Also, Anderson does not teach that the downloaded application 760 was a one-time-deal (i.e., no more new application 760 could be obtained at a latter date which, since 760 now had control, would anticipate that application 760 had communications software). Also, looking for application files to execute was a search;

f) regarding claim 9, claim 15, and 16, Anderson does not teach an appliance comprising an acquisition module and/or logic that is adapted to automatically receive software that facilitates communication between the appliance and a device. **However**, as indicated above, the digital camera contained the required acquisition logic and/or module(s) to automatically connect to a network and download a new application program 760 of which control is so passed and thus requires, at minimum, interfacing with drivers 754; such linking between the application 760 and driver 754 is facilitating communications between the digital camera and external devices.

2. Per the appellant's arguments, beginning on page 14, the appellant argued the rejection under 102(e) as anticipated by Anderson US 6,222,538 B1 by stating in substance that:

a) regarding claim 1, claim 9, claim 15, and claim 16, nowhere is it stated in Anderson that the digital camera contains logic and/or acquisition module is configured to automatically receive software, from a network, that facilitates communication between the appliance another device. **However**, col. 10 (line 40-et seq.) clearly states that the application program, downloaded from a network, is to run in place of the original control application. If the camera is to retain any communication with the outside world, such communication was required since the original application was replaced by the new application;

b) regarding claim 5, Anderson does not teach an appliance that is adapted to periodically search for software for the appliance. **However**, it was anticipated that the digital camera actively looked for and retrieved software from the software source (i.e., that which provided application program 760 via the network to the camera) from time to time as application programs were known to become obsolete in favor of more updated driver versions. Clearly, the download could not come to pass if the application program was not available. Also, Anderson does not teach that the downloaded application 760 was a one-time-deal (i.e., no more new application 760 could be obtained at a latter date which, since 760 now had control, would anticipate that application 760 had communications software). Also, looking for application files to execute was a search.

3. Per the appellant's arguments, being on page 17, the appellant argued each of the rejection under 103(a) as obvious by stating in substance by stating that:

a) the appellant notes that examiner's reliance on Anderson et al. US 6,567,122 B1 and Anderson et al. (US 6,636,259 B1) in rejecting claims 1-20 raises serious questions about the legitimacy of the rejections under 35 U.S.C. 102. **However**, that which was anticipated was obvious and thus a rejection under 35 U.S.C. 103 does not weaken a rejection under 35 U.S.C. 102 but strengthens it;

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b) neither of the Anderson taught or suggested an appliance that received software that facilitates communication between the appliance and another device. **However**, as shown above, each directly taught that the application program was directly downloaded from a network to replace the current control application that did communicate. If the downloaded new replacement application lacked such communication facilities, the digital camera would lose its ability to communicate and thus be rendered useless. Nonetheless, as indicated above, the Web Server applications could have been one of the downloaded application 760 as mentioned above;

c) regarding the rejections under 35 U.S.C. 103, the appellant notes that the Office Action does not state that neither of the Anderson provided a teaching, or a legitimate suggestion, of receiving with or providing to an appliance software that facilitates communication between the appliance and another device. **However**, as stated above, the Anderson reference implemented with respect to 35 U.S.C. 102 clearly taught their network downloaded applications were drop in replacement for the current control application. If the digital camera(s) is(are) to retain any communication capability (i.e., get even newer application programs, download pictures to a personal computer, run a web site with a Web Server program as application program 760), communication capabilities must be retained by the new software/program. If the new download software/program is void of such communication facilities, the camera become useless. As indicated above, it would have been obvious to those skilled in the art, such as Anderson, to download a Web Server application program as one of the application program 760 mentioned above.

3. For all or the reasons set forth supra, it is respectfully requested that the rejections as presented be sustained.

XII. Period for Response to New Ground of Rejection.

No extension of time is permitted for filing a Reply Brief under 37 C.F.R. 1.136(a).

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Submitted by:

A handwritten signature in black ink, appearing to read 'Robert B. Harrell', with a long horizontal flourish extending to the right.

Robert B. Harrell
(Primary Examiner: Art Unit 2142)

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Andrew T Caldwell (SPE)
(Supervisory Patent Examiner: Art Unit 2142)

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Kenneth R. Coulter
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